

a clerical error therein. Claims 56, 70, 79, 88, 91 and 92 have all been amended to clarify that the claimed notch is "adapted" for receiving a thickness gauge.

Applicant respectfully submits that the Amendment places the case in better condition for allowance and/or reduces issues for appeal and therefore should be entered. Applicant also respectfully requests reconsideration as indicated below.

Rejections under § 112

- (1) Claims 59, 66, 73 and 82 stand rejected under the written description requirement of 35 USC § 112, first paragraph. The Examiner states that the specification does not support a spoke extending between second and third strips wherein the third strip is the smallest in diameter and the second strip is the largest. The Examiner has identified an error in the claims which has been corrected. Applicant thanks the Examiner for her careful attention.

- (2) Claims 62, 69, 77, 78, 89 and 90 stand rejected under 35 USC § 112, second paragraph as being indefinite. The Examiner states that it is considered improper to relate features recited in the body of a claim to features recited in its preamble. Claim 62, for example, relates the size of the claimed gasket to the flanges recited in the preamble.

Applicant respectfully submits that any rejection must be grounded either in the MPEP or the case law. With regard to rejections under 35 USC §112, MPEP 2173 *et seq.* sets forth various potential grounds for considering a claim indefinite or improper. However, Applicant cannot find any provision making the assertion made by the Examiner. Rather, the definiteness requirement is explained as being for informing the public of the boundaries of what constitutes infringement of the [ultimate] patent. For the claim to be considered indefinite, therefore, there should be some reason why a member of the public could not ascertain the boundaries of what is being claimed. The Examiner's basis for the rejection should provide this reason, otherwise the rejection should be withdrawn.

Rejections Under §102

(3) Claim 55 stands rejected under 35 USC §102(e) as being anticipated by Carr, U.S. Patent No. 5,362,115 (“Carr”). Applicant respectfully traverses the rejection. Without reaching the issue of whether Carr discloses the invention of claim 55, a patent reference is prior art under 35 USC §102(e) only where it is granted on an application filed “by another.” Since the application on which the Carr patent issued was filed by the present inventor, it was not filed “by another” and the rejection is therefore improper¹.

(4) Claims 55 and 59 stand rejected under 35 USC §102(b) as being anticipated by Oberhuber, U.S. Patent No. 1,869,577 (“Oberhuber”). Applicant respectfully traverses the rejections.

Oberhuber discloses sealing rings 20 and spacers 25. The sealing rings are made of a “resilient material” and the spacers are preferably made of a “spring material.” Each of these materials is apparently a metal, and there is no apparent reason why these elements could not be formed of the same metal. However, Applicant respectfully submits that they are not the formed of the same “sealing” material as claimed.

The Examiner may be taking the position that the term “sealing material” simply means “material” (e.g., high carbon steel), since any material *could* be formed or adapted for use in sealing. However, Applicant respectfully submits that the Examiner should not construe the term so as to render the word “sealing” therein superfluous or meaningless, because it is a fundamental canon of claim construction that claims should not be construed in such manner. The claimed sealing material *is* a material that is adapted for sealing and, clearly, the spacers 25 in Oberhuber are not adapted or appropriate for sealing.

(5) Claims 88 - 90 stand rejected under 35 USC §102(b) as being anticipated by Hubbard, U.S. Patent No. 1,942,704 (“Hubbard”). Claim 88 requires a single ring of sealing material having a concave notch for receiving a thickness gauge. The Examiner identifies radial slots 23(b)

¹ See also paragraph (7), *infra*.

in the gasket of Figure 5 of Hubbard as being equivalent to the claimed notch. Applicant respectfully traverses the rejections.

First, the Examiner appears to base the rejection on a general assertion that functional language² may not provide a patentable distinction as a matter of law. Such a position is flatly contradicted by MPEP §2173.05(g) (functional limitations may serve to *define the invention*).

Moreover, even if the Examiner were correct about the import of functional language, it remains that a *prima facie* case requires some evidence that the identical invention is disclosed in a single prior art reference³. Here, the claims require (1) a single ring of sealing material, (2) having an outer periphery that is substantially congruent with the outer periphery of at least one of the flanges, and (3) including a concave notch. Not only has the Examiner not yet alleged that Hubbard discloses a gasket having all of these features, it is clear by inspection that Hubbard does not.

Hubbard discloses a gasket having two elements. One is disclosed as being a sealing element 21, and the other is disclosed as being a centering element 22(b). It is the centering element 22(b), and not the sealing element 21, which carries the radial slots 23(b).

The sealing element 21 of Hubbard is not substantially congruent with the outer periphery of at least one of the flanged ends 20, and it does not have any concave notch, so it cannot be the claimed single ring of sealing material.

Alternatively, the Examiner may contend that the centering element 22(b) is a ring of sealing material, even though the reference explicitly shows that the element 22(b) is not involved in sealing at all (see Figures 1 and 3). However, even if the centering element 22(b) is taken as a ring of sealing material, the reference does not disclose a *single* ring of sealing material, since the sealing element 21 is also a ring of sealing material.

² These claims have been amended to make it explicit that “for . . .” means “adapted for . . .”, to make it completely clear that functional language is being used.

³ Applying *In re Warner*, 379 F.2d 1011, 1016 (CCPA 1967) to MPEP 2131.

Rejections Under §103

(6) Claims 56 - 58, 85 - 87, 91 and 92 stand rejected under 35 USC §103 as being obvious in view of Oberhuber. The Examiner states that Oberhuber discloses strips designed with a groove/notch or concavity 22 at the inner periphery and a convexity or rib 24 at the outer periphery to facilitate attachment of the spacers 25. Applicant respectfully traverses the rejections.

Claims 56, 57, 58, 91 and 92 recite a concave notch for receiving a thickness gauge. As discussed above (paragraph (5)), the Examiner may not simply ignore an express claim limitation, whether it be expressed in functional terms or not. There is no reasonable way to interpret the surface 22 of Oberhuber as being adapted for receiving a thickness gauge, and no reason to believe that Oberhuber suggests such an adaptation.

Claims 85 and 87 do not recite any concavity or convexity, so the Examiner's stated grounds for the rejection do not even pertain to these claims.

Claim 86 recites a concavity at a corner of the square outer periphery of one of the strips of sealing material. There is no reasonable way to interpret the surface 22 as being at the corner of a square ring 20 that is shown and described as being circular⁴.

More fundamentally, however, Oberhuber does not disclose loops and spokes formed of sealing material as recited in the base claims. Moreover, Oberhuber does not recognize the advantage of providing loops and spokes formed of sealing material, so it does not motivate or suggest providing loops and spokes formed of sealing material. Accordingly, the rejected claims are patentable regardless over Oberhuber irrespective of the merit of the Examiner's arguments here.

⁴ The Examiner states that it is unnecessary to show that Oberhuber teaches, motivates or suggests rings that are square and a concavity that is at a corner because these features are "considered" a mere design choice and not an invention. Applicant is not aware of any provision in the MPEP that authorizes the Examiner to merely "consider" a claimed feature obvious, regardless of what Applicant has or has not taught in his specification. If there is such authority within MPEP §§2142 - 2144 et seq. or the case law, the Examiner should identify it; otherwise, she should withdraw these rejections.

(7) Claims 60 - 62, 67 - 69 and 73 - 78 stand rejected under 35 USC §103 as being obvious in view of Carr and further in view of Smith, U.S. Patent No. 4,002,344 (“Smith”). Applicant respectfully traverses the rejection at least on the ground that Carr is not prior art. Among other reasons that Carr is not prior art⁵, Carr is a §371 of Serial No. PCT/US93/05343, and the present application is a §371 of Serial No. PCT/US94/08087, which is a CIP of Serial No. PCT/US93/05343.

(8) Claims 60, 63 - 67, 70 - 72, 76 and 79 - 84 stand rejected under 35 USC §103 as being obvious in view of Oberhuber and Smith. The Examiner states that Oberhuber discloses first and second strips and an inner spoke while Smith discloses an open or closed alignment spoke.

Regardless, neither Oberhuber nor Smith disclose loops and spokes formed of sealing material as recited in the base claims. Neither reference recognizes the advantage of providing loops and spokes of sealing material and therefore neither reference motivates or suggests loops and spokes formed of sealing material. For that reason alone, irrespective of the Examiner’s argument concerning whether Smith discloses open or closed alignment spokes, the claims are patentable over these references.

CONCLUSIONS AND REQUEST FOR RECONSIDERATION

Applicant has given the Examiner the benefit of the doubt in responding (in remarks) to the contentions regarding Oberhuber. Technically, the Examiner has not tendered a *prima facie* case for either anticipation⁶ or obviousness⁷ because she has not alleged that the rings and spacers either are or are suggested to be all of “said sealing material” as claimed. Where the Examiner has not first alleged the basic requirements for anticipation or obviousness, there is no *prima facie*

⁵ See, e.g., paragraph (3), *supra*.

⁶ *In re Warner*, 379 F.2d 1011, 1016 (CCPA 1967).

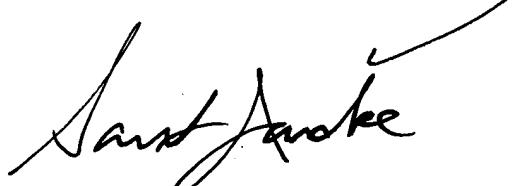
⁷ MPEP §2142.

case obligating Applicant to respond. Notwithstanding, Applicant has amended the claims to clarify for the Examiner that functional language is being used, to remove that as a possible issue on appeal, should that become necessary.

The rejections based on Carr are improper.

The Examiner is respectfully requested to clarify other grounds of rejection as discussed above, because Applicant cannot respond to grounds of rejection that appear to be without authority in the MPEP or the case law. For that reason, to the extent the Examiner would maintain rejections for which no authority has been cited, Applicant respectfully submits that the final rejection is premature and requests reconsideration under MPEP 706.07(d). The Examiner is respectfully requested to provide Applicant a complete and proper ground for each rejection along with a fair opportunity to respond.

Respectfully submitted,



Garth Janke
Attorney for Applicant
Reg. No. 40,662
(503) 228-1841

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